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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,296	02/05/2004	Wolfgang Bredow	BREDOW7	3232

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EXAMINER

DAVIS, CASSANDRA HOPE

ART UNIT PAPER NUMBER

3611

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/771,296

Applicant(s)

BREDOW ET AL.

Examiner

Cassandra Davis

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Specification***

1. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

### ***Claim Rejections - 35 USC § 112***

1. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. In claim 1, line 1, the phrase "the function" lacks antecedent basis.
3. In claim 2, it is unclear if the "numbers or pictorial symbols" are on the first layer or the second layer. In claim 1, the applicant recite that the "numbers and pictorial symbol is provided on said first section". In claim 2, the applicant recites "a second section composed of a clear second film carrying the number or pictorial symbol". Similarly, in claims 7 and 8, it is unclear if the "numbers or pictorial symbols" are on the first layer or the second layer.
4. In claim 6, line 4 and claim 12, line 4, the phrase "said upper side" lacks antecedent basis.
5. In claim 7, line 2, the phrase "the function" lacks antecedent basis.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 3, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Lesko, U. S. Patent 6,129,963.

With respect to claim 1, Lesko teaches a laminate sign or marking element comprising a first section composed of a first film 10 having a luminescent layer 20 to be applied to a support surface and an indicia 14 is provided on the first section.

With respect to claim 2, Lesko teaches the marking element further comprises a second section composed of a clear second film 16 carrying the number or pictorial symbol 14, wherein the second section is applied on the first section.

With respect to claim 3, Lesko teaches the marking element having an adhesive layer 12 and paper release layer 11 on the film 10 opposite the image 14.

With respect to claim 6, Lesko teaches a luminescent layer 20 secured to the film 10 and an adhesive and paper release layer on the luminescent layer. (See column 3, line 28-30).

8. Claims 1, 6, 7, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Rohne et al., US 2003/0167669A1.

Rohne teaches label with luminescent inside comprising first film layer 14, indicia 18 and luminescent ink 16 on one side of the film layer 14. Rohne also teaches an adhesive layer 12 on a side of the film opposite the indicia and luminescent and a paper cover sheer 22 over the adhesive. The label is adapted to be attached to a key of a keyboard.

With respect to claims 7, the key corresponds to the control element.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 2, 4, 7, 8, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ho et al., U. S. Patent 5,468,532 in view of Rohne et al.

Ho et al. teaches multiplayer graphic articles comprising a transparent first layer (first second) 18, a second layer (second section) 16, the first image layer 12, second image layer 14, an adhesive layer 20 and a removable layer 22. Ho et al. does not teach the image layers 12 or 14 having luminescent material. Rohne teaches a label with luminescent material comprising first film layer 14, indicia 18 and luminescent ink 16 on one side of the film layer 14. Rohne also teaches an adhesive layer 12 on a side of the film opposite the indicia and luminescent and a paper cover sheer 22 over the adhesive.

It would have been obvious to one having ordinary skill in the art the time this invention was made to construct the graphic article taught by Ho et al. with luminescent material as taught by Rohne to provide means to visualize the image in the dark.

With respect to claims 2 and 8, Ho et al. teaches a second section (second layer) 16 composed of a clear film carrying the indicia 14 and 12, wherein the second section 16 is applied on the first section. Although Ho et al. does not specifically state that the layer 16 is transparent, layer 16 is inherently transparent so that the image layers 14 and 12 can be seen there through. (Figure 2 and column 7, lines 30-46).

With respect to claims 4, 9, and 10, the second section 16 is a self-adhesive film with an adhesive layer 20 and removable protective backing 22 disposed on a reverse side of the film of the second section.


Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ho et al. in view of Rohne et al. as applied to claims 4 and 9, respectively above, and further in view of Buck, U. S. Patent 5,851,614.

Buck teaches self adhesive decal comprising first film layer 14, indicia 24 printed in reverse image on one side of the film layer 14, and opaque layers 26 (second layer). Buck also teaches an adhesive layer 30 on the same side as the indicia on the film and a paper cover sheer 16 over the adhesive. It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct image on the first layer the device taught by Ho et al and Rohne et al. in reverse image as taught by Buck to provide a means to clearly see the image in the correct orientation when view from the front side of the first layer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cassandra Davis whose telephone number is 703-308-2223. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 703-308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Cassandra Davis  
Primary Examiner  
Art Unit 3611

CD  
September 28, 2004